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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/611,843 | 07/01/2003 | Tommy E. White | GP-302711 | 2769 |

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EXAMINER

MORROW, JASON S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3612

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,843

Applicant(s)

WHITE ET AL.

Examiner

Jason S. Morrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-18 and 20-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose how the inner member can be made in one-piece and the outer member can be made in one-piece. It is unclear how each of these members could be constructed according to the techniques disclosed by the applicant, as they are far more complex than any frame member made in one-piece according to the prior art. It is unclear how the members could be constructed without welding or joining in some manner smaller pieces to construct the inner or outer member.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 8, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroeder et al. '458.

Re claim 1, Schroeder et al. discloses a body and frame assembly for a vehicle comprising a one-piece inner member (16) mated with a one-piece outer member (12), each of the members defining door openings for opposing sides of the vehicle (the door openings of the inner member oppose the door openings of the outer member).

Re claim 8, the inner and outer members define holes for at least one of door hinges, wiring and trim components (the inner and outer member door openings are holes for trim members, that being doors and their associated components).

Re claim 16, the inner member and the outer member are joined at least partially by bonding (column 1, line 47).

Allowable Subject Matter

5. Claim 19 is allowed.

Response to Arguments

6. Applicant's arguments filed 7/22/04 have been fully considered but they are not persuasive with regard to the claims rejected.

The applicant argues with respect to the 112, first paragraph rejection that one reasonably skilled in the art could make or use the invention from the disclosure in the application and with information known in the art. As support for this assertion, applicant refers to the disclosures of U.S. Patents 6,253,588 and 5,974,847. While both of these references show quick plastic

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forming and super plastic forming to be well known in the art, neither discloses how to make an object such as that disclosed by applicant. Both references show making body parts of relatively common size and relatively flat composition in comparison to applicant's invention. In contrast, to be made from a single sheet of metal, the applicant's invention would seemingly have to be made from an excessively large sheet of metal requiring numerous complex bending steps not taught by either of the references. Applicant points out that the Rashid et al. reference refers to the decklid contemplated by that reference as being "a challenging one-step, one piece forming operation". If that object is challenging, then the object contemplated by applicant is above and beyond that comprehended by the Rashid et al. reference and certainly not with the skill level of one reasonably skilled in the art. The invention of applicant contains numerically more bends and more complex bends than shown by the prior art. The Examiner is not disputing that quick plastic forming, super plastic forming, and hydroforming are not well known techniques. What the Examiner is disputing that it is well known to use such techniques to make a **one-piece** vehicle frame member of the size and shape depicted by applicant. Frame members of the size and shape shown by applicant are typically made in small sections and welded together or joined in some other manner (see the Teply et al. reference). Some are made of tubular members joined together to form a whole frame member (see the Jaekel et al. reference). Applicant should produce prior art showing a one-piece vehicle frame member of the size and complexity contemplated by applicant to prove that the technique for making such a frame is well known in the art. If the process is readily apparent to one of ordinary skill in the art and no prior art reference can be found, then some explanation should be given as to why all prior art frames of

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similar size and complexity are made of multiple sections joined together rather than in one-piece as applicant suggests.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason S. Morrow whose telephone number is (703) 305-7803. The examiner can normally be reached on Monday-Friday, 8:00a.m.-4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 20, 2004

Jason S. Morrow
Examiner
Art Unit 3612


JASON MORROW
PRIMARY PATENT EXAMINER

9/20/04